

REMARKS/ARGUMENTS

The Examiner in his communication dated January 25, 2007, required the election of a single species as set forth in the examples of the specification. Accordingly, Applicant elects, with traverse, the species 2,2-bis[3-(isopropylamino)-4-hydroxyphenyl]propane which is disclosed on page 22, Examples 15 and 16.

All of the claims read on the elected species.

The Examiner alleges that the species recited in the Examples of the specification are patentably distinct. However the burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinction. M.P.E.P. § 803.

Applicant respectfully traverses the election/restriction requirement on the grounds that no adequate reasons and/or examples have been provided to support patentable distinctness. Rather, the Office merely stated conclusions.

Accordingly the Office has failed to meet the burden necessary to sustain the election requirement, and the Office has not shown that a burden exists in searching all of the species.

Moreover, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.”

Applicant submits that a search of the entire Claim 1 would not constitute a serious burden on the Office.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together. Separate substances, which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics should be examined together if they have at least one property in common

which is mainly responsible for the claimed relationship. The same entity in a generic sense suffices.

Applicant makes no statement regarding the patentable distinctness of the species, but note that for the restriction/election to be proper there must be patentable differences between the species as claimed. M.P.E.P. § 808.01(a). Applicant's election is for examination purpose only.

Further, Applicant reserves the right to file divisional applications on the non-elected subject matter, if so desired, and be accorded the benefit of the filing date of the parent application. Divisional applications filed thereafter claiming non-elected species are not subject to a double patenting ground of rejection. 35 U.S.C. § 121; In re Joyce (Comr. Pats 1957) 115 USPQ 412.

Applicant requests that should the elected species be found allowable, the Examiner expand the search to include non-elected species.

Applicant respectfully submits that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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